

**REMARKS**

Claims 1-4 are pending in the present application.

**Objection to the Drawings**

The Examiner objected to the drawings because they failed to show the "recirculated heating fluid 32" and the "bypass passage 22". By the present amendment the "recirculated heating fluid 32" item has been deleted from the specification. Also, Applicants have submitted a drawing sheet containing a replacement figure 1 with the "bypass passage 22" item illustrated. Accordingly, withdrawal of the objection to the specification is respectfully requested.

**Objection to the Specification**

The Examiner objected to the Specification because of several minor informalities. By the current amendment, Applicants have presented several replacement paragraphs correcting the informalities singled out by the Examiner. Accordingly, withdrawal of the objection to the specification is respectfully requested.

**Rejection Under 35 U.S.C. §103**

The Examiner has rejected claims 1-4 under 35 U.S.C. §103 as being obvious in view of the combination of McClure, Jr., U.S. Patent No. 4,365,547 ("McClure") and Eguchi, Japanese Patent Publication No. 40-2070406A ("Japan '406"). The present application relates to a press installation constructed to regulate the temperature of the press, and specifically the temperature of the press platens contained inside the press. (Paragraph 0015). The temperature of these platens (which compress the wood-additive mixtures into pressed boards or other composite products) is regulated by controlling the temperature of the oil supplied to the press platens. By changing the blend of cooler and warmer oil that is supplied to the press, the temperature of the platens can be regulated to within a relatively fine degree of tolerance. (Id.)

McClure discloses a press apparatus for controlling the time-temperature relationship during the pressing and manufacture of laminate assemblies. (Col. 2, lines 7-12). Laminates made using this apparatus have improved quality and uniformity because the press cycle temperatures are more consistent and uniform. (Col. 2, lines 9-16). In this apparatus, a desired temperature cycle is entered into an electronic set point programmer, and this programmer then, in

cooperation with an electronic process controller, delivers instructions to the input valve of the heat transfer medium supply source as well as the by-pass valve to maintain the heat transfer medium at the desired press cycle step temperature while the medium circulates through the press elements. (Col. 5, line 57 - Col. 6, line 17).

The Japan '406 patent fairly discloses an apparatus for regulating the temperature of a molding die in order to stabilize the dimension of a molded product and increase the molding yield. (See the "Abstract" section of the attached "Patent Abstracts of Japan" document). The apparatus has a pair of heat medium channels through which flows a heat medium, which is sensed by an external temperature sensor as it exits the heat medium channels. (See the "Constitution" section of the attached "Patent Abstracts of Japan" document). The flow control valves which regulate the flow of the heat medium into the channels are then adjusted so as to maintain the temperature of one cavity within a set value of a reference cavity. (Id.)

Out of the group of claims rejected, only claim 1 is independent.

Claim 1 recites:

An apparatus for the production of wood composite boards, comprising: (a) a press having platens for forming the board; and (b) means for regulating the temperature of the platens, the regulating means including: (i) means for circulating a heating fluid through the platens, (ii) means for detecting the temperature of the heating fluids as it exits the platens; and (iii) means for responding to the detected temperature for heating the fluid supplied to the platens.

The combination of McClure and Japan '406 does not teach or suggest an apparatus for the production of wood composite boards that includes a press having platens, in which there is a means for detecting the temperature of the heating fluids as it exits the platens, and means for responding to the detected temperature for heating the fluid supplied to the platens. Because an obviousness rejection under 35 U.S.C. §103 requires that the references, as modified or combined, must teach or suggest all of the elements of the claims, (M.P.E.P. §2143), the instant claims are clearly allowable.

In the Office Action of October 28, the Examiner asserts that McClure teaches all of the elements of claim 1 except for the element of claim 1 reciting a means for detecting the temperature of the heating fluids as it exits the platens. (Office Action of October 28, Page 3). However, the Examiner asserts that Japan '406 discloses a heating medium and a means for

detecting the temperature as it exits the heating medium. The Examiner asserts that it would have been obvious to one having ordinary skill in the art to provide McClure's apparatus with the means for detecting the temperature as it exits the heating medium as taught by Japan '406 for the purpose of controlling the flow of heat medium. Applicants respectfully disagree with this analysis and traverse this rejection as follows.

First, Applicants assert that a *prima facie* case of obviousness has not been established because the Japan '406 reference upon which the Examiner has relied is not analogous prior art to the presently claimed subject matter and thus, applying Japan '406 to teach certain elements of the present claims is inappropriate.

In order to rely on a prior art reference under 35 U.S.C. §103, the Examiner has the affirmative duty to determine whether the reference is analogous prior art:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (M.P.E.P. §2141.01(a)) (citations omitted).

As used above, "reasonably pertinent" means:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. (*Id.*) (citations omitted).

In the present case, Japan '406 discloses a process for regulating the temperature of a die in order to stabilize the dimensions of a molding product and increase molding yield. By contrast, the present invention is directed to an apparatus or press for the production of wood boards. There is no relationship between these two technologies, and thus, the Japan '406 disclosure is well outside the technical field of the Applicant's invention.

Not only is the Japan '406 reference outside the technical field of the applicant's endeavor, but additionally there does not appear to be any teaching in the Japan '406 reference that is reasonably pertinent to the problem addressed by the Applicants' presently inventive subject matter. The problem that Applicants faced was that of more closely controlling the temperature of the press platens during press platen operation. By contrast, it appears that Japan '406 deals with

an entirely separate matter: regulating the temperature of a molding die in order to stabilize the dimension of a molded product and increase the molding yield. There does not appear to be any aspect of the Japan '406 reference that is pertinent to the problem addressed by the Applicants in the present invention.

Moreover, one of ordinary skill in the art would not have a reasonable expectation that McClure could be successfully combined with Japan '406 as suggested by the Examiner. In order to establish *prima facie* obviousness based on a combination of prior art references, the Examiner must show that there is some reasonable expectation for successfully combining the references in the manner suggested by the Examiner. M.P.E.P. §2143. Extensive modifications would be necessary to successfully combine McClure and Japan '406.

In the present case, a person of ordinary skill would not have any such reasonable expectation. For example, it is important to note that McClure and Japan '406 place the temperature regulating means in exactly opposite locations: in Japan '406 the temperature of the heat medium is taken, and the temperature adjusted, *after* it exits the die and the heat medium. By contrast, in McClure, the heat medium temperature is detected *before* the heat medium is directed into the press. (Col. 4, lines 7-30). Thus, in order to carry out the Examiner's proposed modification (i.e., to modify McClure so that the McClure apparatus detects the heat medium temperature as it exits the apparatus) it would be necessary to move McClure's temperature detecting and regulating means from its current position, to a new position *downstream* of the McClure apparatus. This would appear to render the McClure device inoperable, as it appears that a necessary aspect of the McClure device is that the blow-off valve 8 be located on the opposite side of the laminating press of the steam valve 12. Thus, in order to combine McClure with Japan '406, it would be necessary for a person of ordinary skill in the art to make several critically important modifications of the devices taught in the references. Considering that there is no teaching in either McClure or Japan '406 providing any guidance as to making such modifications, one of ordinary skill in the art would not have a reasonable expectation that McClure could be successfully combined with Japan '406 as suggested by the Examiner.

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Finally, the combination of McClure and Japan '406 fails to teach or suggest all of the elements of the present claims.

Therefore, based on the above remarks, the Examiner has failed to establish that claims 1-4 are obvious in view of McClure and Japan '406. Reconsideration and withdrawal of the rejections of claims 1-4 are respectfully requested.

**CONCLUSION**

Reconsideration and withdrawal of the objection and rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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